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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,113	09/18/2002	Peter A. Montana II	PM01	8210
27797	7590	06/29/2004	EXAMINER	
RICHARD D. FUERLE 1711 W. RIVER RD. GRAND ISLAND, NY 14072			ELKINS, GARY E	
			ART UNIT	PAPER NUMBER
			3727	
			DATE MAILED: 06/29/2004	

*7*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/065,113

Applicant(s)

MONTANA, PETER A.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-12, 15, 16 and 18, drawn to a can carton package and pattern pieces, classified in class 229, subclass 103.
  - II. Claims 13, 14, 17, 19 and 20, drawn to a method of making a hat and a hat, classified in class 2, subclass 200.3.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II, claims 13, 17 and 19 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in another and materially different process as claimed. For example, the can carton package and pattern pieces of claims 1-12, 15, 16, and 18 can be used by physically punching the pieces from the carton(s) as opposed to claims 13, 17 and 19 which require the step of cutting out the patterns from the can cartons. Also, the can carton package can be used to make, e.g. a bowl or spacer as opposed to claims 13, 17 and 19 which require steps to make a hat, i.e. the can carton package could be used by assembling the pieces into a bowl or spacer as opposed to claims 13, 17 and 19 which require the step of assembling the pieces into a hat.
3. Inventions I and II, claims 14 and 20 are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if

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the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful to make a bowl or as a spacer for fitting between stacked cartons and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

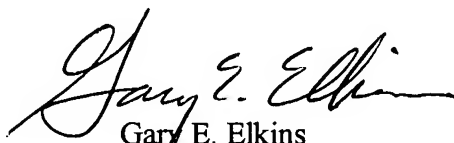
6. It is noted that the above requirement is based upon the claims as best understood. The claims appear to be indefinite in that it is unclear what constitutes the "package" being set forth, i.e. what secures or otherwise holds together the elements being combined into the claimed "package". As disclosed and shown in the drawings, the cartons/blanks are separate elements which are merely intended to be used together. A "package" would require some element to secure or otherwise hold them together, i.e. to "package" them together.

7. Also, the application is unclear with respect to how one blank or carton can be used to make a hat, i.e. how the pattern on a single carton alone is used to make a hat. None of the embodiments shown or described in the specification are formed from a single carton or blank. The only embodiment set forth requires at least two cartons or blanks, i.e. one to form the brims and one to form the crown. Claim 1 is defining one can carton with one pattern that has the ability to form a hat and claim 2 defines that the pattern on the single carton includes both a brim and a crown. In summary, the application appears to lack enablement for an embodiment where the pattern pieces that form the hat are cut from a single carton.

8. Appropriate rejections/objections regarding the above problems will be made upon examination on the merits.

### *Conclusion*

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

  
Gary E. Elkins  
Primary Examiner  
Art Unit 3727